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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/507,315
Filing Date: September 10, 2004
Appellant(s): ZASCHKE ET AL.

Richard L. Chinn
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12-10-09 appealing from the Office action mailed 6-10-08.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on 8-19-08 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of Claim 16 (and now cancelled claim 17) under 35 USC 112 2nd paragraph {set forth beginning at the 7th to last line of page 3 of the final Office action mailed 6-10-08} is withdrawn by examiner.

Additionally, claim 17 has been removed from all grounds of rejection as it has been cancelled by the amendment after the final Office action received 8-19-08 which was entered.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

0,786,480	BREUKEL ET AL.	7-1997
6,127,443	PERRY ET AL.	10-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the appellant regards as his invention.

Claims 1, 2, and 4-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellant regards as the invention.

Appellants' claims are confusing as to intent because it can not be determined what degree of overlap in particle size distribution are intended to be included by the claim limitation "the peaks of the large and small particles...do not overlap". As determination of the beginning and end of a "peak" is a subjective determination,

determination of what degree of overlap in particle size distribution is intended by the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP-0,786,480 in view of Perry et al.(6,127,443).

EP-0,786,480 discloses preparations of polyurethane articles using polymer polyols which include polymer particles having narrow particle size distributions inclusive of the particle size distributions defined by appellants' claims (see abstract, as well as, the entire document).

EP-0,786,480 differs from appellants' claims in that combinations of different polymer polyols are not employed. However, Perry et al. discloses formations of combinations of polymer polyols for the purpose of realization of unitary polyol mixtures for use in making energy management urethane articles (see column 5 and examples 1-5, as well as, the entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed blends of polymer polyols as disclosed by Perry et al. in the making of polyol materials and polyurethane articles of EP-

0,786,480 for the purpose of achieving unitary polyol mixtures of combined polymer polyol ingredients for imparting the energy management effects of in order to arrive at the products and processes of appellants' claims with the expectation of success in the absence of a showing of new or unexpected results.

It has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402 . Further, a prima facie case of obviousness has been held to exist where the proportions of a reference are close enough to those of the claims to lead to an expectation of similar properties. *Titanium Metals v Banner* 227 USPQ 773. **(see also MPEP 2144.05 I)** Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980). The size of particles employed in the formation of polymer polyols are well studied, and polymer particle size differences have well known and expected effects on the stabilities and viscosities of the polyols which containing said polymer particles and on the physical properties of articles realized from the polymer polyols formed. Combinations of results arriving from the employment of blends of these polymer polyols having different particle sizes is not seen to rise above optimization of that which is known from the teachings of the prior art, and a demonstrated showings of new or unexpected results commensurate in scope with the scope of the claims is not seen to have been set forth in the evidence of record.

(10) Response to Argument

Appellants' arguments have been considered. However, rejection is maintained.

As to the rejection under 35 USC 112 2nd paragraph, it is held and maintained that appellants' specification does not provide guidance for determining where separation exist between the two peaks defined by the claims such that the metes and bounds of the claims as they currently stand can be definitively determined.

Confusion in the claims does not reside in what is meant by "overlap", but, rather, it resides in determining when a peak begins or ends, and then, accordingly, when said overlap of peaks would begin and end. One having ordinary skill in the art can not readily determine what distributions of particle sizes are included or excluded by the claims as they currently stand.

Though the submitted declaration is useful in establishing some guidance as to what degrees of observed particle distribution in the valleys between distribution peaks may be fairly interpreted as no particle presence (It is noted though that the data for example 2 even raises questions about this guidance), it does not address the fundamental problem, in the instant case, that the ordinary practitioner can not readily determine what distributions of particle sizes are included or excluded by the claims as they currently stand.

Further, the declarant's conclusory opinion that the "peaks are well separated and do not overlap" is of no probative value in overcoming the instant rejection because this opinion and the evidence which supports it does not address the problem that one

of ordinary skill in the art can not readily determine what distributions of particle sizes are included or excluded by the claims as they currently stand.

Even example 2, also mentioned above, helps begin to exemplify the confusion associated with appellants' claims. Is the approach to zero of this example sufficient to be deemed no overlap? The declaration and the other evidence of record do not establish what degree of an approach to zero constitutes no overlap as currently claimed by appellants.

Further, the submitted opinion declaration is unpersuasive for the claims as they currently stand because the tests referred to in appellants' arguments and declaration are not reflected by the claims. The claims do not reflect the test conditions referred to by appellants' arguments and declaration.

Finally, when looking to the originally filed supporting disclosure for its guidance in determining the meaning of features of the claims and determining where and when separation between peaks exist, its assistance in definitively identifying what degrees of overlap between particle size distribution are included or excluded by the metes and bounds of the claims as they currently stand is not definitively provided or set forth by the evidence of appellants' originally filed specification and claims.

As to the rejection under 35 USC 103, appellants' arguments have been considered. However, rejection is maintained for the reasons set forth above.

It is the secondary teaching that is looked to for the teaching and the motivation to employ blends of polymer polyols. It is not seen that looking to the secondary

teaching for its teaching of the use of blends of polymer polyols in the manner indicated in the rejection above would destroy the essential teachings of the primary reference as alleged by appellants. Though the primary reference is directed towards employment of polyols having narrow particle size distribution, it is not seen that employing multiple polymer polyols as provided for by the secondary teaching to arrive at preparations involving blends of polymer polyols having more than one narrow particle size distribution would destroy the essential teachings of the primary reference.

Appellants' latest arguments have been considered, but are unpersuasive for all the reasons stated, again, above. It is maintained that the reasons for combination of the teachings are proper, and Perry et al. is properly looked to for its disclosure of employment of multiple polymer polyol compositions. It is not looked to for the disclosure of narrow particle size distributions in the employed polymer polyol, this narrow particle distribution is already provided for by the primary references. In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Rejection is based on the combined teachings of the cited prior art, and operation within the combined teachings of the cited prior art in order to arrive at the products and processes of appellants' claims is maintained to be evident.

Further, that the primary teaching may be most interested in a single narrow particle size distribution does not negate the combination of the teachings as set forth in

the rejection above, nor does it negate the expectation of success from the combination of the teachings of the cited prior art. Again, it is the combination of the prior art which must be looked at for what it fairly teaches not each teaching individually.

It is held and maintained that rejection is proper for the reasons set forth above. Perry et al. is looked to for its disclosure of employment of combinations of polymer polyols. Polymer polyols having narrow particle distributions are provided for by EP-0,786,480, and examiner maintains that blends of different polymer polyols having narrow particle distributions would have been within the purview of the ordinary practitioner in the art based on the combined teachings of EP-0,786,480 and Perry et al.

Additionally, it is held and maintained that it is within the skill of the ordinary practitioner to arrive at a bicompositional composition from two different components, with each component having different and independent narrow particle distributions, from operating within the teachings of the combined prior art in order to arrive at the products and processes of appellants' claims.

As to any distinction between graft and polymer polyols that may be alleged. It is held that it is widely known that polymer polyols are also referred to as graft polymer polyols, graft polyols, or copolymer polyols; all of these terms are used to describe products that are basically stable dispersions of vinyl polymers in polyols. Polymer polyols are produced by the in-situ polymerization of a vinyl monomer in a base polyol. Appellants' do not identify differences in the material make-ups of their claims such that

distinction between graft polyols of the claims and polymer polyols of the cited prior art is evident.

The evidence of record is not sufficient in negating examiner's position of obviousness, nor is sufficient evidence of new or unexpected results, commensurate in scope with the scope of the claims, set forth that would overcome the position of obviousness set forth.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

John M. Cooney, Jr.

/John Cooney/

Primary Examiner, Art Unit 1796

Conferees:

/James J. Seidleck/

Supervisory Patent Examiner, Art Unit 1796

/Benjamin L. Utech/

Primary Examiner